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10/684,001	10/10/2003	Stephen Gold	200309328-1	3200
22879 7590 05/13/2008 HEWLETT PACKARD COMPANY P O BOX 272400, 3404 E. HARMONY ROAD INTELLECTUAL PROPERTY ADMINISTRATION FORT COLLINS, CO 80527-2400			EXAMINER CAMPOS, YAIMA	
			ART UNIT	PAPER NUMBER
			2185	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/684,001	<b>Applicant(s)</b> GOLD ET AL.	
	<b>Examiner</b> YAIMA CAMPOS	<b>Art Unit</b> 2185	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-10,12-19 and 21-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-10, 12-19, 21-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. As per the instant Application having Application number 10/684,001, the examiner acknowledges the applicant's submission of the amendment dated January 18, 2008. At this point, claims 1, 3-10, 12-19, 21-25 have been amended and claims 2, 11, 20 and 26 stand canceled. Claims 1-10, 12-19, and 21-25 are pending.

#### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 18, 2008 has been entered.

### **REJECTIONS NOT BASED ON PRIOR ART**

#### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 17-19 and 21-25 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The language of the claims raises a question as to whether the claims are directed merely to an environment or machine which would result in a practical application producing a concrete useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

Art Unit: 2185

4. Claims 17-19 and 21-22 are rejected because the modules recited in these claims are implemented as software routines as evidenced in paragraph 0017 of Applicant's Specification. Therefore these claims are system of software per se, failing to fall within a statutory category of invention.

5. Claims 23-25 are rejected because it is unclear whether the recited machine-readable medium comprises a tangible medium (e.g. storage medium) or a non-tangible medium (e.g. transmission or propagation medium).

6. To expedite a complete examination of the instant application the claims rejected under U.S.C. 101 (nonstatutory) above are further rejected as set forth below in anticipation of application amending these claims to place them within the four categories of invention.

## **REJECTIONS BASED ON PRIOR ART**

### **Double Patenting**

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. **Claims 1, 17 and 23** are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 12 (dependent from claim 10) of copending Application No. 10/684,207.

Art Unit: 2185

8. Initially, it should be noted that the present application and Application No. 10/684,207, have the same inventive entity. The assignee for both applications is Hewlett-Packard Development Company, L.P.
9. Claimed subject matter in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as noted below. *See In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993).*
10. Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See MPEP § 804.
11. For example, claim 1 of the instant Application is compared with claim 12, dependent from claim 10 of Application No. 10/684,207. (The rationale in the comparison to claim 1 show bellow also applies to claims 17 and 23 of the instant Application).

<b>Instant Application</b>	<b>Application 10/684,207</b>
Claim 1  A method comprising:  obtaining information <u>regarding a future backup</u> from one or more backup applications for a plurality of backup jobs;	Claims 10  A method comprising: receiving a list comprising media and at least two backup devices, wherein a first medium in the list is assigned to a first backup device, and a second medium in the list is assigned to a

	<p>second backup device; ordering the list by physical location of the at least two backup devices; and presenting at least the media portion of the ordered list to a user, wherein receiving the list of media comprises receiving a list of media from a user to be used for one or more future executions of one or more backup jobs associated with the backup devices, said method further comprising, before receiving the list,</p>
<p>calculating a <u>projected</u> number of media for a <u>future execution</u> of at least one of the backup jobs using the information <u>regarding the future backup</u>, said calculating <u>also</u> comprising dividing an average historical backup size of the backup job by an average capacity of a media type associated with the backup job</p>	<p>12. (Original) The method of claim 10, wherein calculating the required number of scratch media comprises for at least one of the future executions, dividing an average historical backup size of the backup job by an average capacity of a media type associated with the backup job.</p>

and presenting the <u>projected</u> number of media to a user.	<p>Claim 10</p> <p>calculating a required number of scratch media needed for the future executions and presenting the required number of scratch media to the user.</p>
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**Claim Rejections - 35 USC § 103**

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. **Claims 1, 3-5, 8-10, 12-19 and 21-25** are rejected under 35 U.S.C. 103(a) as being unpatentable over Bolin et al. (US 5,664,146) in view of Kanai et al. (US 2002/0152181).

14. As per **claims 1, 17 and 23**, Bolin discloses a method/system/machine readable medium having stored thereon sequences of instructions comprising: obtaining information regarding a future backup from one or more backup applications for a plurality of backup jobs; **[Bolin discloses migration and backup of data (col. 7, lines 5-8) wherein all cartridges are used for storage of data, and are intended to be written to or read in the future (figure 5 and related text) wherein application programs in the host processor send commands to task module (col. 7, line 27-48)]**

Art Unit: 2185

calculating a projected number of media for a future execution of at least one of the backup jobs using the information regarding the future backup, and presenting the projected number of media to a user [**Bolin discloses all cartridges are used for storage of data, and are intended to be written to or read in the future (figure 5 and related text) wherein step 260 in figure 6 is can be considered as presenting a projected number of one media to be loaded and used (figure 6 and related text); GUI for “alerting an operating to the need for mounting or demounting a particular data medium” (col. 5, lines 58-63; col. 7, lines 39-40)].**

Bolin does not explicitly disclose the details of “said calculating also comprising dividing an average historical backup size of the backup job by an average capacity of a media type associated with the backup job”.

Kanai discloses a plurality of backup jobs wherein “said calculating also comprising dividing an average historical backup size of the backup job by an average capacity of a media type associated with the backup job” as [**“providing the estimation of future storage usage of the user by the rental storage service provider based on the history of storage usage of the user; and reporting the estimation to the storage user” (Page 1, Pars. 0018-0019; Pars. 0202, 0225 and 0234) wherein “the rental storage service provider 2 will estimate the future usage of storage data based on the history record of the usage data stored in the storage device(s) to report to the rental storage service user 1 the estimation” (Page 4; Par. 0091; Figure 2 and related text). See recommended capacity graph (Page 8, Par. 0176 and Figure 17)].**



Art Unit: 2185

Bolin et al. (US 5,664,146) and Kanai et al. (US 2002/0152181) are analogous art because they are from the same field of endeavor of computer memory access and control.

At the time of the invention it would have been obvious to a person of ordinary skill in the art to modify the storage management method/system as taught by Bolin and further provide details of a plurality of backup jobs and said calculating comprising, for at least one of the future executions, dividing an average historical backup size of the backup job by an average capacity of a media type associated with the backup job as disclosed by Kanai.

The motivation for doing so would have been because Kani discloses **[that rented storage allows users to be released from the burden of maintenance of store and thereby have less responsibility of administration (Par. 0005) wherein “the contract user will have the amount of data more than the currently contracted capacity of 300GB... this display screen may provide the user interface which is very easy to operate and easy to understand for the rental storage service users” (Pages 8-9; Par. 0176)].**

Therefore, it would have been obvious to combine Kanai et al. (US 2002/0152181) with Bolin et al. (US 5,664,146) for the benefit of creating a method/system medium having stored thereon sequences of instructions to obtain the invention as specified in claims 1, 17 and 23.

15. As per **claim 3**, the combination of Bolin and Kanai discloses the method of claim 1, wherein obtaining the information regarding the future backup further comprises obtaining information for one or more backup devices, each backup device associated

Art Unit: 2185

with at least one of the backup jobs [**Bolin discloses all cartridges are used for storage of data wherein each device as shown in figure 5 corresponds to a storage job (figure 5 and related text; col. 7, lines 1-26)**].

16. As per **claim 4**, the combination of Bolin and Kanai discloses the method of claim 3, wherein presenting the projected number of media comprises presenting the projected number of media required for each of the backup devices [**Bolin discloses wherein step 260 in figure 6 is can be considered as presenting a projected number of media to be loaded and used (figure 6 and related text); GUI for “alerting an operating to the need for mounting or demounting a particular data medium” (col. 5, lines 58-63; col. 7, lines 39-40)**].

17. As per **claim 5**, the combination of Bolin and Kanai discloses the method of claim 1, wherein obtaining the information regarding the future backup further comprises obtaining information for one or more media pools, each media pool associated with at least one of the backup jobs [**Bolin discloses migration and backup of data (col. 7, lines 5-8) wherein all cartridges are used for storage of data, and are intended to be written to or read in the future (figure 5 and related text) wherein application programs in the host processor send commands to task module (col. 7, line 27-48). The embodiment of figure 4 also covers individual media pools (col. 7, line 64-col. 8, line 3) and explains library dataserver displaying mount messages for a tape subsystem forming part of a plurality of tape subsystems (col. 9, lines 3-36; figures 4-5 and related text)**].

18. As per **claims 8, 18-19 and 24-25**, the combination of Bolin and Kanai discloses the method of claim 5, wherein presenting the projected number of media comprises

Art Unit: 2185

presenting the projected number of media for each of the media pools [**Bolin discloses library dataserwer displaying mount messages for a tape subsystem forming part of a plurality of tape subsystems (col. 9, lines 3-36; figures 4-5 and related text) wherein step 260 in figure 6 can be considered as presenting a projected number of media to be loaded and used (figure 6 and related text)**].

19. As per claim 9, the combination of Bolin and Kanai discloses the method of claim 5, wherein calculating further comprises using the media pool information to analyzing historical usage of the media pools as [**Kanai discloses “providing the estimation of future storage usage of the user by the rental storage service provider based on the history of storage usage of the user; and reporting the estimation to the storage user” (Page 1, Pars. 0018-0019; Pars. 0202, 0225 and 0234)**].

20. As per claim 10, the combination of Bolin and Kanai discloses the method of claim 5, further comprising presenting a report to the user identifying at least one media pool having a greater amount of media than the projected number of media for the at least one media pool [**Bolin discloses eject messages for media that is not required to be included in the projected number of media for future storage jobs (figure 5 and related text)**].

21. As per claims 12-13, the combination of Bolin and Kanai discloses The method of claim 1, further comprising: wherein obtaining the information regarding the future backup further comprises obtaining information for one or more media pools, each media pool associated with the backup jobs; and wherein calculating the projected number of media further comprises totaling the number of media projected for each media pool to be used by the future execution; wherein the obtaining the information regarding the future

Art Unit: 2185

backup further comprises obtaining information for one or more backup devices associated with the backup jobs; and wherein calculating the projected number of media further comprises totaling the projected number of media for each backup device to be used by the future execution [Bolin discloses migration and backup of data (col. 7, lines 5-8) wherein all cartridges are used for storage of data, and are intended to be written to or read in the future (figure 5 and related text) and step 260 in figure 6 is can be considered as presenting a projected number of one media to be loaded and used (figure 6 and related text); GUI for “alerting an operating to the need for mounting or demounting a particular data medium” (col. 5, lines 58-63; col. 7, lines 39-40) and explains having different tape pools (figure 4 and related text). Kanai discloses “providing the estimation of future storage usage of the user by the rental storage service provider based on the history of storage usage of the user; and reporting the estimation to the storage user” (Page 1, Pars. 0018-0019; Pars. 0202, 0225 and 0234) wherein “the rental storage service provider 2 will estimate the future usage of storage data based on the history record of the usage data stored in the storage device(s) to report to the rental storage service user 1 the estimation” (Page 4; Par. 0091; Figure 2 and related text). See recommended capacity graph (Page 8, Par. 0176 and Figures 17 and 28) wherein the total capacity of the storage system is shown and the total recommend capacity for certain time periods is also shown].

22. As per claim 14, the combination of Bolin and Kanai discloses the method of claim 1, wherein calculating further comprises calculating the projected number of media for the future execution of the backup jobs scheduled within a predetermined period of

Art Unit: 2185

time [**Bolin discloses all cartridges are used for storage of data wherein they are intended to be written to or read in the future (figure 5 and related text) wherein step 260 in figure 6 can be considered as presenting a projected number of media to be loaded and used within a predetermined period of time (figure 6 and related text); note eject messages are sent to the user when media is not longer necessary. Furthermore, Kanai discloses estimation of future storage based on usage history of the user (Page 1, Pars. 0018-0019)**].

23. As per **claims 15 and 21**, the combination of Bolin and Kanai discloses the method of claim 1, further comprising receiving from the user a list of one or more media to be used [**Bolin discloses cartridge (col. 9, line 51-col. 10, line 43; figure 5 and related text)**].

24. As per **claims 16 and 22**, the combination of Bolin and Kanai discloses the method of claim 15, further comprising for each media in the list, determining if the media is a valid media [**Bolin discloses "if the wrong volser has been mounted, the host issues a demount job and then reissues a mount job, starting from step 236" (col. 11, line 52-54)**].

25. **Claims 6-7** are rejected under 35 U.S.C. 103(a) as being unpatentable over Bolin et al. (US 5,664,146) in view of Kanai et al. (US 2002/0152181) as applied to claims 1 and 5 above, and further in view of Carlson et al. (US 2004/0044862).

26. As per **claim 6**, the combination of Bolin and Kanai discloses the method of claim 5, but does not disclose expressly the details of calculating comprises, for each media pool: determining an existing number of media in the media pool; calculating the

Art Unit: 2185

projected number of media for the future execution using the media pool; and subtracting the existing number from the projected number.

Carlson discloses of calculating comprises, for each media pool: determining an existing number of media in the media pool; calculating the projected number of media for the future execution using the media pool; and subtracting the existing number from the projected number as [**“a system administrator may move physical volumes from one storage pool to another when managing the tape cartridges in the storage pools. This may be performed if a determination is made that one storage pool needs additional tapes due to an anticipated increase of data maintained in that pool, or one pool needs fewer tape cartridges due to an anticipated decrease in data directed toward that pool” (Page 3, Par. 0044) and details moving a number of physical volumes from a source pool to a target pool (figures 9-10 and related text)**].

Bolin et al. (US 5,664,146), Kanai et al. (US 2002/0152181) and Carlson et al. (US 2004/0044862) are analogous art because they are from the same field of endeavor of computer memory access and control.

At the time of the invention it would have been obvious to a person of ordinary skill in the art to modify the storage management method/system as taught by the combination of Bolin and Kanai and further calculating a projected number of media by determining an existing number of media in the media pool; calculating the projected number of media for the future execution using the media pool; and subtracting the existing number from the projected number as disclosed by Carlson.

The motivation for doing so would have been because Carlson discloses calculating a projected number of media by determining an existing number of media in

Art Unit: 2185

the media pool; calculating the projected number of media for the future execution using the media pool; and subtracting the existing number from the projected number is done to maintain the optimal number of cartridges in a storage pool [(par. 0044)].

Therefore, it would have been obvious to combine Kanai et al. (US 2002/0152181) with Bolin et al. (US 5,664,146) and Carlson et al. (US 2004/0044862) for the benefit of creating a method/system medium having stored thereon sequences of instructions to obtain the invention as specified in claim 6.

27. As per **claim 7**, the combination of Bolin, Kanai and Carlson discloses the method of claim 6, wherein determining the existing number further comprises determining if a protected period for one or more existing data media has expired [**Kanai discloses “the reporting process will also be executed if a predetermined period of time has expired” (Par. 0158) which comprises a time period for the contract for data storage**].

#### **ACKNOWLEDGMENT OF ISSUES RAISED BY THE APPLICANT**

##### **Response to Amendment**

28. Applicant's arguments filed on January 18, 2008 with respect to Carlson have been considered but they are moot in view of new grounds of rejection.

29. Applicant's arguments filed on January 18, 2008 with respect to Kanai have been fully considered but they are not persuasive.

30. As required by **M.P.E.P. § 707.07(f)**, a response to these arguments appears below.

**ARGUMENTS CONCERNING PRIOR ART REJECTIONS**

31. Claims must be given the broadest reasonable interpretation during examination and limitations appearing in the specification but not recited in the claim are not read into the claim (See M.P.E.P. 2111 [R-1]).

32. Applicant remarks Kanai does not disclose how many media to use as Kanai discloses how much storage space might be used; however, the Examiner would like to respectfully point out that the number of storage media is directly correlated to the storage space storage media is able to provide; therefore, as Kanai discloses estimated storage space, Kanai is inherently discloses the number of storage media to use. As estimated storage requirement increases and is provided by a system, the number of storage media must also increase.

33. In response to Applicant's remark that Kanai does not disclose "calculating a required number of scratch media needed for one or more future executions of the... backup jobs," the calculating comprising "dividing an average historical backup size of the backup job by an average capacity of a media type associated with a backup job;" these remarks have been fully considered but are not persuasive.

Kanai discloses "obtaining backup job information from one or more backup applications for a plurality of backup jobs," as [**"providing the estimation of future storage usage of the user by the rental storage service provider based on the history of storage usage of the user; and reporting the estimation to the storage user"**] (Page 1, Pars. 0018-0019; Pars. 0202, 0225 and 0234) wherein **"the rental storage service provider 2 will estimate the future usage of storage data based on the history record of the usage data stored in the storage device(s) to report to the rental storage**



Art Unit: 2185

service user 1 the estimation” (Page 4; Par. 0091; Figure 2 and related text). See recommended capacity graph (Page 8, Par. 0176 and Figure 17). *Applicant should note that saving/storing data by a user within rental storage system comprises backup procedures from one or more backup applications and that as it is estimated the future storage usage of the user for the rental storage by the rental storage service provider, the rental storage service provider considers either directly/indirectly “backup job information from one or more backups applications for a plurality of backup jobs,” as it considers “history of usage”; and provides an estimate of storage that the user will need in order to accommodate backup jobs by the user to the rental storage].*

Kanai clearly discloses “calculating a required number of scratch media needed for one or more future executions of the... backup jobs,” as [**“providing the estimation of future storage usage of the user by the rental storage service provider based on the history of storage usage of the user; and reporting the estimation to the storage user”** (Page 1, Pars. 0018-0019; Pars. 0202, 0225 and 0234). *Applicant should note that saving/storing data by a user within rental storage system comprises backup procedures from one or more backup applications; therefore, when estimating the number of future storage usage by a user; the rental storage service provider is calculating required number of media needed for one or more future executions of backup jobs].*

Kanai also discloses the calculating comprising “dividing an average historical backup size of the backup job by an average capacity of a media type associated with a backup job;” as [**“providing the estimation of future storage usage of the user by the rental storage service provider based on the history of storage usage of the user; and**

Art Unit: 2185

reporting the estimation to the storage user” (Page 1, Pars. 0018-0019; Pars. 0202, 0225 and 0234) wherein “the rental storage service provider 2 will estimate the future usage of storage data based on the history record of the usage data stored in the storage device(s) to report to the rental storage service user 1 the estimation” (Page 4; Par. 0091; Figure 2 and related text). See recommended capacity graph (Page 8, Par. 0176 and Figure 17). *Applicant should note that as Kanai considers the usage history (which corresponds to the average historical backup size of the backup job as it takes into consideration the usage history for a certain amount of time in order to provide the estimated future usage) and amount of data (in Gigabytes) to provide the estimated usage (which is deemed to be any number of Gigabytes as shown by the estimated usage line)].*

34. The Examiner would also like to point out that the functional recitations of "configured to [or capable of]" do not make the claimed invention patentably distinct over the prior art of record. While features of a system may be recited either structurally or functionally, claims directed to a system must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431- 32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also In re Swinehart, 439 F.2d 210, 212-13, 169 USPQ 226,228-29 (CCPA 1971 ); In re Danly, 263 F.2d 844, 847, 120 USPQ 528,531 (CCPA 1959). "System claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original).

Art Unit: 2185

Still further, claims 17, and 21-22 recite, inter alias, "configured to [or capable of]." While these limitation require structures such as an integration agent in claim 17, the functional recitations following the terms "configure to" do not distinguish the claim from the prior art. .

35. All arguments by the applicant are believed to be covered in the body of the office action; thus, this action constitutes a complete response to the issues raised in the remarks dated January 18, 2008.

### **CLOSING COMMENTS**

#### **Examiner's Note**

36. Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

#### **Conclusion**

##### **a. STATUS OF CLAIMS IN THE APPLICATION**

37. The following is a summary of the treatment and status of all claims in the application as recommended by **M.P.E.P. 707.07(i)**:

##### **a(1) CLAIMS REJECTED IN THE APPLICATION**

Art Unit: 2185

38. Per the instant office action, claims 1, 3-10, 12-19, and 21-25 received a first action on the merits and are subject of a non-final rejection.

**a(2) CLAIMS NO LONGER UNDER CONSIDERATION**

39. Claims 2, 11, 20 and 26 stand canceled as of amendment date January 18, 2008.

**b. DIRECTION OF FUTURE CORRESPONDENCES**

40. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yaima Campos whose telephone number is (571) 272-1232. The examiner can normally be reached on Monday to Friday 8:30 AM to 5:00 PM.

**IMPORTANT NOTE**

41. If attempts to reach the above noted Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Sanjiv Shah, can be reached at the following telephone number: Area Code (571) 272-4098.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

April 29, 2008

/Yaima Campos/  
Examiner, Art Unit 2185

/Sanjiv Shah/  
Supervisory Patent Examiner, Art Unit 2185